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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,232	12/18/2001	German Tello	7401	5674

7590 02/06/2004

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EXAMINER

ALVO, MARC S

ART UNIT PAPER NUMBER

1731

DATE MAILED: 02/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

Office Action Summary

Application No.

10/020,232

Applicant(s)

TELLO ET AL

Examiner

Steve Alvo

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO99/13041 (equivalent U.S. Patent 6,156,714 used for translation).

The “for use” clause has not been given probative weight in the composition (claims 1-13 or method of making (claims 14-16) claims. WO99/13041 teaches a solid fatty acid composition wherein the fatty acid is at least partially saponified with an alkaline substance, see 6,156,714 column 2, lines 20-31) wherein the alkaline substance can be an amine, e.g. triethanol amine (column 2, lines 30-31). See column 3, lines 52-57, for using stearic, lauric, myristic, palmitic or behenic acids as the fatty acid. These are the same fatty acids used by Applicant; see specification, page 2, lines 24-29. See column 4, lines 19-22 for non-ionic dispersants (POE). See column 3, lines 38-51 for degrees of saponification of 1 to 30%. Claims 14-16 are rejected as Example 1 teaches preparing the solid soap (pellet) by mixing the ingredients in a kneader for 2 hours. If necessary obviously the kneader of WO99/13041 would mix the ingredients. If necessary, obviously the claimed degrees of saponification would be obvious from the ranges

taught by WO99/13041. If necessary, obvious to use a non-ionic surfactant for the surfactant of WO99/13041 as Applicant has not shown any criticality for the claimed non-ionic surfactant and discloses that any surfactant can be used, see specification, page 3, lines 12-14.

Claim 9 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO99/13041 (equivalent U.S. Patent 6,156,714 used for translation) as applied to claim 8 above, and further in view of BENTLEY (5,968,313).

If necessary with respect to claim 9, BENTLEY teaches making solid soaps by saponifying (column 5, lines 13-15) the same fatty acids taught by WO99/13041, e.g. See BENTLEY, column 4, lines 48-52, for using stearic, lauric, myristic, palmitic or behenic acid as the fatty acid in the production of solid soap pellets. BENTLEY also teaches that surfactants, including non-ionic surfactants, e.g. alkoxyated (C8-C16 fatty alcohols and esters thereof, could be present in the soap composition (paragraph bridging columns 4 and 5). If the surfactants of WO99/13041 are not non-ionic, then it would have been obvious to use the non-ionic surfactants of BENTLEY, e.g. alkoxyated (C8-C16 fatty alcohols and esters thereof, in the solid soap composition of WO99/13041 for their known function of dispersing the ingredients. Claims 17-20 are rejected as BENTLEY teaches using solid soap pellets saponified with an alkali to de-ink recycle paper, see BENTLEY, column 7, lines 21, 28, 39 and 55; column 6, lines 55-56 and TABLES for solid soap pellets. The compositions of BENTLEY are very similar if not the same as the compositions made by WO99/13041; the same fatty acids are saponified and formed into solid pellets. It would have been obvious to use the solid soap pellets of WO99/13041 to de-ink recycle paper in the manner taught by BENTLEY.

Claims 17 and 19 are rejected under 35 U.S.C. 102(b) as anticipated by BENTLEY.

BENTLEY teaches adding solid soap pellets saponified with an alkali to recycle paper to de-ink the recycle paper, see BENTLEY, column 7, lines 21, 28, 39 and 55; column 6, lines 55-56 and TABLES for solid soap pellets. The compositions of BENTLEY are very similar if not the same as the compositions made by Applicant; the same fatty acids are saponified and formed into solid pellets, see column 4, lines 48-52, for using stearic, lauric, myristic, palmitic or behenic acid as the fatty acid in the production of solid soap pellets. These are the same fatty acids used by Applicant. Any difference would have been an obvious modification over BENTLEY.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over BENTLEY in view of WO99/13041 (equivalent U.S. Patent 6,156,714 used for translation).

BENTLEY teaches adding solid soap pellets saponified with an alkali to recycle paper to de-ink the recycle paper, see BENTLEY, column 7, lines 21, 28, 39 and 55; column 6, lines 55-56 and TABLES for solid soap pellets. The compositions of BENTLEY are very similar if not the same as the compositions made by WO99/13041; the same fatty acids are saponified and formed into solid pellets. BENTLEY teaches making solid soaps by saponifying (column 5, lines 13-15) the same fatty acids taught by WO99/13041, compare WO99/13041; column 3, lines 52-57, for using stearic, lauric, myristic, palmitic or behenic acids as the fatty acid with BENTLEY, column 4, lines 48-52, for using stearic, lauric, myristic, palmitic or behenic acid as the fatty acid in the production of solid soap pellets. It would have been obvious to make the solid soap pellets of BENTLEY in the manner taught by WO99/13041.

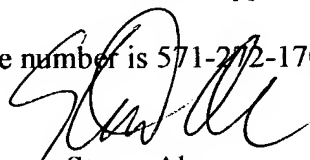
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Alvo whose telephone number is 571-272-1185. The examiner can normally be reached on 6:00 AM - 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1700.



Steve Alvo
Primary Examiner
Art Unit 1731

msa
January 23, 2004